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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/088,719      | 06/19/2002  | Takako Fujii         | M2096-4             | 5004             |

7278 7590 07/13/2004

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EXAMINER

FLYNN, AMANDA R

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3743

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/088,719

Applicant(s)

FUJII ET AL.

Examiner

Amanda R. Flynn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-9,13,14 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-9,13,14 and 25-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 31 March 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-2, 7-9, 13-14 and 25-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Per MPEP, section 608.01(m) regarding the Form of Claims: "Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters that may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims." (Emphasis added)

Reference characters ((A), (B), etc.) appear throughout the pending claims. The claims must be definite and be able to stand alone, even when the claims are read without the reference letters that appear in parentheses after the structure that the letters are attempting to identify, per MPEP 608.01(m). Reference characters have no effect on the scope of the claims.

Therefore, claims 1-2, 7-9, 13-14 and 25-41 are indefinite because it is unclear what exactly is claimed. For example, if Applicant were to read claim 2 without considering the reference characters, it is unclear what is the "strong straining portion" identified in claim 1, versus the "strong straining portion" identified in claim 2. Reference characters have no effect on

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the scope of the claims. Yet without the reference characters, the claims are unclear and indefinite.

It is suggested that the claims and specification be amended to incorporate identifying language into the body of the claims. For example, in claim 1, the "strong straining portion (A)" could be amended to read: --a first strong straining portion--. While in claim 2, the "strong straining portion (B)" could be amended to read: --a second strong straining portion--. The specification should be amended to reflect this language. Such an amendment will not be considered to incorporate new matter.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2, 7-9, 13-14 and 25-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-2, 7-9, 13-14 and 25-41 recite an apparatus that is attached to a part of the human body. Specifically, in claim 1 the applicant recites "wherein the garment covers at least a part of the lower body of a wearer, has a crotch part, and is worn by being fitted to the wearer's body." Claims reciting a portion of, or an attachment to, the human body contain non-statutory subject matter. 1077 OG 24 (April 21, 1987).

Applicant can overcome this rejection by amending claim 1 to recite, "wherein the garment is adapted to covers at least a part of the lower body of a wearer, has a crotch part, and is adapted to be worn by being fitted to the wearer's body."

***Claim Objections***

5. Claims 1, 2, 7-9 and 25-28 are objected to because of the following informalities:

In line 12 of claim 1, it is unclear what the "right and left" refer to. It is suggested that the phrase --the wearer's-- be inserted before "right and left". Similar problems occur in claims 2, 7-9 and 25-28 and should be addressed.

In line 2 of claims 25 and 26, "staining" should be replaced with --straining--.

Appropriate correction is required.

Additionally, it is suggested that the claims be amended to read more fluidly. For example, in claim 2, insertion of the article "a" in line 4, before "hypogastric" and in line 7 before "hypogastric", would make the claims read more clearly. Similar minor amendments to the other claims would have a similar effect.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

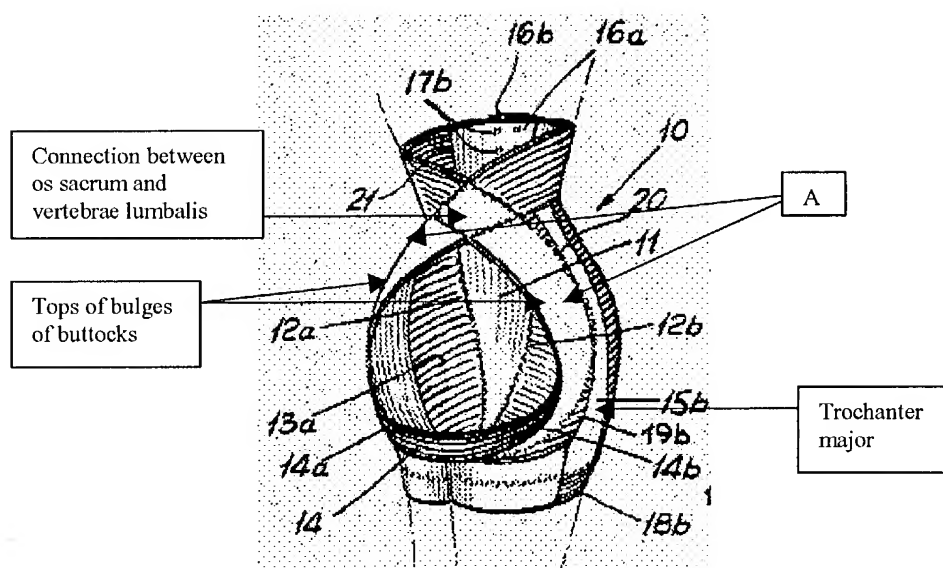
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 3,756,247 to Hand.

Hand discloses a garment (10) comprising a stretch fabric wherein the garment covers at least a part of the lower body of a wearer, has a crotch part, and is worn by being fitted to the wearer's body, wherein: the garment in part has a portion with a strong straining force (14); the portion with a strong straining force is a strong straining portion (A); right and left parts of the

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portion (A) are connected at a position on the back side of the garment corresponding to any region from os sacrum to vertebrae lumbalis of the wearer's body (see figure below); and the portion (A) covers a region extending from said position through tops of bulges of the buttocks or vicinities thereof approximately in the direction of muscle fibers of musculus gluteus maximus at right and left to at least the vicinity of trochanter major. The garment further comprises a strong straining portion (11), wherein right and left parts of the portion (B) are connected at a position on the garment corresponding to musculus rectus abdominis in the hypogastric region, and the portion (B) covers a region extending obliquely downward from the position on musculus rectus abdominis in hypogastric region approximately in the direction of muscle fibers of musculus obliquus internus abdominis at right and left to at least the vicinity of trochanter major.



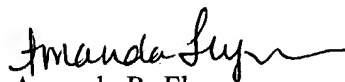
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***Conclusion***

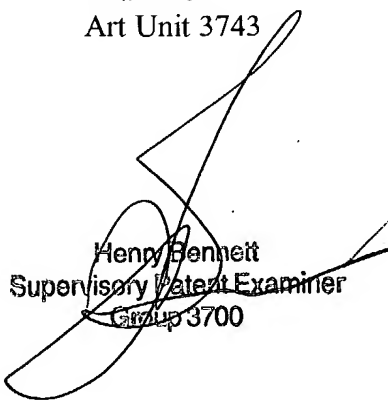
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda R. Flynn whose telephone number is 703-306-4056. The examiner can normally be reached on Monday-Thursday, 8:30 - 6:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Amanda R. Flynn  
Examiner  
Art Unit 3743

arf

  
Henry Bennett  
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